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PTO/SB/33 (07-05)

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  45702	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____		Application Number  10/658,208	Filed  September 10, 2003
		First Named Inventor  Won-Kyung Seong	
		Art Unit  2622	Examiner  Michael Lee

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- attorney or agent of record. Registration number 57,805.
- attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

Gautam Sain

Typed or printed name

(202) 659-9076

Telephone number

March 24, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

<input checked="" type="checkbox"/>	*Total of <u>1</u> forms are submitted.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: ) Atty. Docket No.: 45702  
                        ) )  
**Won-Kyung Seong** ) ) Confirmation No.: 3224  
                        ) )  
Serial No.: 10/658,208 ) ) Group Art Unit: 2622  
                        ) )  
                        ) )  
Filed: September 10, 2003 ) ) Examiner: Michael Lee  
                        ) )  
For: APPARATUS AND METHOD ) ) Customer No.: 01609  
                        ) ) FOR DISPLAYING TELEVISION  
                        ) ) VIDEO SIGNAL IN MOBILE  
                        ) ) TERMINAL

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ARGUMENTS FOR CONSIDERATION FILED CONCURRENT  
WITH PRE-APPEAL BRIEF REQUEST FOR REVIEW

Attn: Mail Stop AF  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the final Office Action of December 24, 2008, Applicant submits arguments for consideration with the concurrently filed Pre-Appeal Brief Request For Review.

**Remarks/Arguments:**

Applicant respectfully submits that the double patenting rejection is improper.

Claims 1, 3-8, 11-15 and 18 were provisionally rejected by the Examiner for non-statutory obviousness-type double patenting as being un-patentable over claims 1-16 of co-pending patent application no. 10/658,545.

Applicant respectfully traverses this rejection since the present application was filed on the same day as co-pending application Serial No. 10/658,545, Applicant respectfully requests the Examiner to withdraw the double patenting in the present application because the present application comprises the base invention and the co-pending application comprises an improvement.

Specifically, under MPEP § 804.I.B, a provisional double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that provisional double patenting rejection is the only rejection remaining in at least one of the application. In the current application, the double

patenting rejection should be withdrawn at least because the provisional double patenting rejection is the only rejection remaining.

Additionally, MPEP § 804.I.B.1 states that if both applications are filed on the same day, the examiner should withdraw the obviousness double patenting rejection in the base application without a terminal disclaimer, while the double patenting rejection in the improvement application cannot be withdrawn without a terminal disclaimer. Accordingly, in the present application, applicant respectfully request the Examiner to withdraw the double patenting rejection without a terminal disclaimer because this application was filed on the same day as co-pending application Serial No. 10/658,545, and the present application comprises the base invention and the co-pending application comprises an improvement.

Additionally, Applicant respectfully traverses the double patenting rejection at least because the Examiner failed to establish a prima facie case of obviousness to support the obviousness-type double patenting rejection. Applicant respectfully requests the Examiner to withdraw the rejection.

Under MPEP § 804.II.B.1, an obviousness double patenting rejection *if not based on anticipation rationale*, is analogous to the non-obviousness requirement of 35 USC § 103 and the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 USC § 103 obviousness determination. Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 USC § 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obviousness double patenting analysis. See MPEP § 804.B.1.

The current rejection is not based on anticipation rationale at least because the Examiner stated that “the conflicting claims are not identical,” and further the Examiner failed to establish the factual inquiries set forth in *Graham* to establish the requirements under 35 USC § 103. The Examiner must either make an assertion that the double patenting rejection is based on anticipation (where conflicting claims must be identical) or must establish the Graham inquiries to make an obviousness determination (as specified in 804.B.1). In this case, first, the Examiner expressly states that “the conflicting claims are not identical”, therefore the double patenting rejection is not based on anticipation. Next, the Examiner makes a general allegation that the rejection is based on the ground of obviousness, however, the Examiner fails to provide an

Application No. 10/658,208

Arguments with Pre-Appeal Brief Request For Review dated March 24, 2009

analysis for obviousness under 35 U.S.C. § 103. To establish a prima facie case of obviousness, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the references. In the present application, the Examiner failed to provide any reason and/or rationale to establish a prima facie case of obviousness. Thus, the obviousness-type double patenting rejection is improper, at least for these reasons.

In view of the above, it is believed that there is at least one or more errors or omissions in the Examiner's rejections. Accordingly, Applicant respectfully requests withdrawal of the rejection.

Respectfully submitted,

Date: March 24, 2009

/Gautam Sain/

Gautam Sain

Reg. No. 57,805

Roylance, Abrams, Berdo & Goodman, L.L.P.  
1300 19<sup>th</sup> Street, N.W., Suite 600  
Washington, D.C. 20036-2680  
Main: (202) 659-9076